

Remarks:

Claims 1-13 and 27-33 are pending in the present Application.

By this Amendment, new claims 30-33 have been added in order to provide for a more adequate basis of protection of the present invention.

Also by this Amendment claims 1 and 27-29 have been amended in order to more particularly point out and distinctly claim the invention. A Request for Continued Examination is being submitted herewith in order to allow for entry of this Amendment.

Rejections under 35 U.S.C. § 102(b):

Claims 1-13 and 27-29 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,758,327 to Gardner et al. ("Gardner").

However, Gardner fails to disclose all of the limitations of claims 1-13 and 27-29 as amended, so Gardner cannot anticipate these claims.

A claim is anticipated by a prior art reference only if the reference discloses or inherently describes every detail of the claim. According to the MPEP, "[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."¹ Also according to the MPEP, "[T]he identical invention must be shown in as *complete detail* as is contained in the ... claim."²

Claims 1-13

Claim 1 as amended recites:

A fulfillment system associated with a distributed supply chain,
comprising:
a database operable to store:

¹ MPEP 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), emphasis added.

² MPEP 2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), emphasis added.

at least one customer-specified rule identifying a sourcing constraint associated with a customer; and

...
one or more processors collectively operable to:

receive an available-to-promise (ATP) request...;

generate one or more component ATP requests using at least

one rule identifying the sourcing constraint;

communicate the component ATP requests to at least one supplier..., the supplier determined according to at least one customer-specified rule identifying the sourcing constraint;

receive a plurality of component quotations from at least one supplier, each component quotation...comprising product availability information for one or more corresponding desired products; and

generate a quotation for communication using the product availability information and the contract value in the database.

(Emphasis added.) Thus, claim 1 relates to a fulfillment system comprising a database and one or more processors. The database stores at least one customer-specified rule identifying a sourcing constraint associated with a customer. The processor(s) are operable to communicate a component request to a supplier, where the supplier is determined according to at least one customer-specified rule identifying the sourcing constraint. Claims 2-13 depend from claim 1 and therefore include the same limitations at least by reference.

Gardner fails to disclose many of the limitations of claim 1, including those limitations noted above. The Gardner system essentially operates according to the flowchart shown in Gardner, Figure 3. The Gardner system provides customers with an online catalog, receives orders, acquires transaction authorizations mandated by the customer's rules, and transmits a purchase order. Note that the only rules referred to in Gardner are rules for mandating certain parties within a company authorize transactions and for mandating minimum bid requirements. Gardner is silent with respect to a customer-specified rule for determining which supplier to use. Thus, Gardner fails to disclose all of the limitations of claim 1. Accordingly, Gardner cannot anticipate claim 1, or claims 2-13, which depend from claim 1.

With respect to independent claims 27-29, each of these claims includes one or more limitations that are similar to those discussed above in connection with claim 1. Thus, Gardner cannot anticipate claims 27-29 for at least the reasons discussed above.

For the reasons set forth herein, the Applicants submit that claims 1-13 and 27-29 are not anticipated by Gardner. The Applicants further submit that claims 1-13 and 27-29 are in condition for allowance. Therefore, the Applicants respectfully request that the rejection of claims 1-13 and 27-29 be reconsidered and that claims 1-13 and 27-29 be allowed.

The Legal Standard for Anticipation Rejections Under 35 U.S.C. § 102:

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.
5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means

known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other

person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of

experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

New Claims:

New claims 30-33 have been added in order to provide for a more adequate basis of protection of the present invention. Claims 30-33 depend from claims 1 and 27-29, respectively. Therefore, claims 30-33 are considered to be allowable for at least the reasons discussed above in connection with claims 1 and 27-29.

Claims 30-33 are further considered to be allowable because these claims recite limitations that are not disclosed or suggested by Gardner.

Conclusion:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

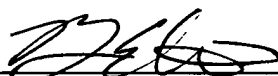
Enclosed herewith is a Request for Continued Examination, which includes an authorization to charge the \$790.00 fee for an RCE to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Amendment to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

21 MARCH 2006

Date


James E. Walton, Registration No. 47,245
Daren C. Davis, Registration No. 38,425
Brian E. Harris, Registration No. 48,383
Michael Alford, Registration No. 48,707
Steven J. Laureanti, Registration No. 50,274
Law Offices of James E. Walton, P.L.L.C.
1169 N. Burleson Blvd., Suite 107-328
Burleson, Texas 76028
(817) 447-9955 (voice)
(817) 447-9954 (facsimile)
jim@waltonpllc.com (e-mail)

CUSTOMER NO. 53184
ATTORNEYS AND AGENTS FOR
APPLICANT